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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 963,554	09 27 2001	Koichiro Nakamura	2001_1477A	8898

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EXAMINER

FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03 31 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/963,554

Applicant(s)

NAKAMURA ET AL

Examiner

Michael J Feely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 24 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-13 are pending in the instant application.

***Claim Objections***

2. The objection to claims 1-13 has been overcome by amendment.

***Drawings***

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on January 24, 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The rejection of claims 1-13 under 35 U.S.C. 112, first paragraph, has been withdrawn.

***Specification***

5. The objection to the disclosure has been withdrawn.

***Claim Rejections - 35 USC § 102/103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. The rejection of claims 1-7 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fehn et al. stands for the reasons set forth in section 10 of the previous Office action (paper #4).

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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9. The rejection of claims 8-13 under 35 U.S.C. 103(a) as being unpatentable over Fehn et al. (US Pat. No. 6,187,890) in view of Suzuki et al. (EP 0195355) stands for the reasons set forth in section 11 of the previous Office action (paper #4).

***Response to Amendment***

10. The declaration under 37 CFR 1.132 filed January 24, 2003 is insufficient to overcome the rejection of: claims 1-7 based upon Fehn et al. (US Pat. No. 6,187,890) under 35 U.S.C. 102 or 103; and claims 8-13 based upon the combination of Fehn et al. (US Pat. No. 6,187,890) and Suzuki et al. (EP 0195355) under 35 U.S.C. 103, as set forth in the previous Office action because: the showing is not commensurate in scope with the claims. Applicant uses Example 6 of Fehn et al. as a comparison to the instant invention. Example 6 uses components (A), (B), and (C) of the instant invention; however, component (D) of the instant invention is not included. Hence, the comparison is not commensurate in scope with the claims, and the showing is insufficient to overcome the rejection.

Section MPEP 716.02(e) instructs that, "an affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979). "Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest (for emphasis) prior art which is commensurate in scope with the claims." *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). "Where there are deviations from the closest prior art, they must 1) be explained and 2) shown unlikely to influence the outcome of the comparison. *In re Finley*, 81 USPQ 383; *Ex Parte Armstrong*, 126 USPQ 281; *In re Widmer*, 147 USPQ 518; *In re Magerlein*, 202 USPQ 473. In the alternative, "Applicants may

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compare the claimed invention with prior art that is more closely related to the invention than the prior art relied upon by the examiner." *In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA 1978).

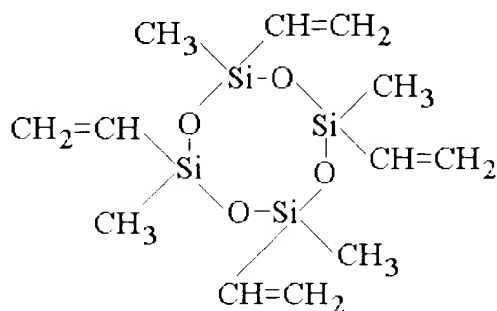
### *Response to Arguments*

11. Applicant's arguments indicate that, "Fehn et al. fail to disclose an adhesive composition including a(n) *organocyclic* silicon compound (D-1) according to claim 1 *as amended*"; however, this is not the case. In the noted amendment, Applicant narrowed the scope of (D-1) from an organic silicone compound having at least three alkenyl groups (with 1-4 carbon atoms) bonded directly to silicon atoms and a molecular weight of less than 1,000 to an *organocyclic* silicon compound having at least three alkenyl groups (with 1-4 carbon atoms) bonded directly to silicon atoms, 3 to 8 silicon atoms per molecule, and a molecular weight of less than 1,000.

As stated in the previous Office action, the claim language discloses two alternate embodiments for component (D): (D-1) and (D-2).

Fehn et al. disclose the use of inhibitors, including polymethylvinylcyclosiloxanes, and more specifically, *1,3,5,7-tetravinyltetramethyltetracyclosiloxane* (column 9, lines 43-51).

1,3,5,7-tetravinyltetramethyltetracyclosiloxane is equivalent to 1,3,5,7-tetravinyl-1,3,5,7-tetramethyltetracyclosiloxane:



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This compound meets the limitations for (D-1) in claims 1-13 (including the specific limitations found in claims 4 and 6).

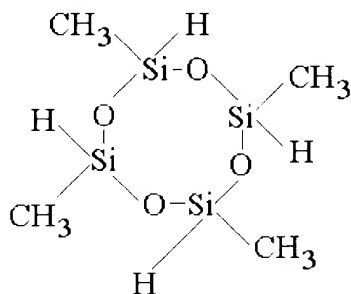
Regarding (D-2), the claim language requires an organic cyclic compound having at least three Si-H bonds per molecule and a molecular weight of less than 1,200. Fehn et al. do not explicitly disclose the use of a compound corresponding to claimed component (D-2) in combination with claimed components (A), (B), and (C). It should be noted that: component (A) of the instant invention corresponds to "Component (A)" of Fehn et al.; component (B) of the instant invention corresponds to "component (B)" of Fehn et al.; and component (C) of the instant invention corresponds to "Component (D)" of Fehn et al.

However, regarding component (B), Fehn et al. disclose, "Of course, it is also possible to use mixtures of different siloxanes which satisfy the criteria of constituent (B). In particular, the molecules forming constituent (B) can also contain aliphatically unsaturated groups in addition to the obligatory SiH groups. Particular preference is given to using low molecular weight SiH-functional compounds such as tetrakis(dimethylsiloxy)silane and *tetramethylcyclotetrasiloxane*, and also high molecular weight, SiH-containing siloxanes such as *poly(hydrogenmethyl)siloxane* and *poly(dimethylhydrogenmethyl)siloxane* having a viscosity at 25° C. of from 10 to 10,000 mPa's, or analogous SiH-containing compounds in which some of the methyl groups are replaced by 3,3,3-trifluoropropyl or phenyl groups." (column 6, 35-49).

Although not explicitly disclosed, these combinations would be capable of satisfying the requirements of both components (B) and (D-2) of the instant invention; hence, yielding an obvious variation of the claimed invention. The high molecular weight compounds, *poly(hydrogenmethyl)siloxane* or *poly(dimethylhydrogenmethyl)siloxane*, would have satisfied

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the requirements for claimed component (B). Combined with tetramethylcyclotetrasiloxane as the low molecular weight compound, this embodiment would have also satisfied the requirements for claimed component (D-2). Tetramethylcyclotetrasiloxane is equivalent to 1,3,5,7-tetramethylcyclotetrasiloxane:



This compound meets the limitations for (D-2) in claims 1-13 (including the specific limitations found in claims 5 and 6).

For these reasons, the amended claims have failed to overcome the prior art of record.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Feely whose telephone number is 703-305-0268. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Michael J. Feely  
March 27, 2003



Robert A. Dawson  
Supervisor  
March 27, 2003